

REMARKS

As a preliminary matter, Applicant submits that the Examiner's remarks in the Advisory Action present an unreasonable interpretation of the Chen reference (U.S. 5,846,648). The Examiner even acknowledges that Fig. 2 of Chen discloses that the grains 74 are not spatially spaced, but then asserts that this limitation from claim 1 is still somehow met because *some* grains in different portions of the drawing can be considered to be "spatially spaced" from other grains not immediately touching such grains on all sides. Not only is such an interpretation entirely unreasonable based on both the present application and the cited reference, it also fails to consider specific teachings in the Chen reference itself that teach away from the present invention.

First, the Examiner is required to interpret any reasonable claim language of the present invention in light of the disclosure to the present application. In this respect, it is entirely clear to one skilled in the art exactly the scope of the present invention, where it is claimed that metallic nucleation sites are spatially spaced on the surface of a substrate. It would not be reasonable to assume that one skilled in the art would interpret such claim language to include nucleation sites that are not touching another nucleation sites on another end of the substrate, but are still entirely contiguous with nucleation sites immediately surrounding and adjacent to the original nucleation site.

Additionally, and irrespective of the unreasonable interpretation of the prior art reference noted above, the Chen reference still cannot form the basis of rejection against the present invention because it teaches away from the present invention. As previously

discussed, Chen specifically teaches that the grains cited by the Examiner are contiguous. In other words, Chen *requires* that all of its grains 74 are touching other grains, and therefore cannot be spatially spaced from such grains. It is a well-established principal of patent law that additional examples of the same element in the structural configuration of one reference are not typically treated as separate elements. Therefore, Chen's grains 74 that appear on one end of the substrate in question are not distinguishable from any other particular grain on another end of the substrate, because the Examiner has shown no teaching or suggestion that any individual grains within the plurality of grains perform different functions. Therefore, Applicant submits that the Examiner may not treat some of Chen's grains 74 differently from others of the same grains, when Chen neither teaches nor suggests any distinguishable differences between them. Therefore, Applicant again submits that Chen specifically teaches away from the present invention, and that the examiner has failed to answer any of these meritorious arguments.

Accordingly, Applicant maintains and incorporates by reference herein those arguments previously advanced in Amendment B, filed August 3, 2004, and Amendment A, filed March 1, 2004. Applicant respectfully requests once again that the Examiner reconsider those arguments, and withdraw the outstanding Section 103 rejection, at least according to the reasons discussed above.

Nevertheless, in the interest of expediting prosecution only, Applicant has further amended claim 1 to clarify that each of the crystal grains of the present invention

contain one of the metallic nucleation sites. Applicant submits that Chen neither teaches nor suggests any such similar feature to its grains 74.

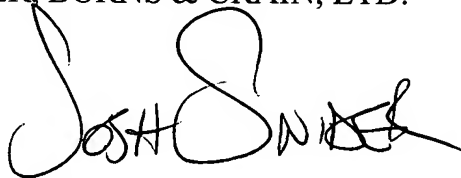
The Examiner asserts that grains 74 of Chen's seed layer 22 are analogous to the nucleation sites featured in claim 1 of the present invention. However, Chen further teaches that the intermediate layer 24, which includes grains 76, is formed over the seed layer 22. Magnetic recording layer 16, which includes grains 78, is then formed over the intermediate layer 24. Chen does not teach or suggest that any one of the grains 74 is contained within the grains 76 or 78, and therefore Chen fails to teach or suggest any of its "nucleation sites" contained inside any of its separate grains, where the grains and the metallic nucleation sites are recited at separate and distinct elements of the same invention. Accordingly, for at least these reasons, and in addition to at least the reasons discussed above, Applicant submits that the outstanding Section 102 rejection based on Chen, and the Section 103 rejection of the dependent claims based at least part on Chen, should be withdrawn.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-6, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "JOSH SNIDER", with a stylized flourish at the end.

Josh C. Snider

Registration No. 47,954

Customer No. 24978

October 4, 2004

300 South Wacker Drive

Suite 2500

Chicago, Illinois 60606

Tel: (312) 360-0080

Fax: (312) 360-9315

P:\DOCS\2500\66134\698367.DOC